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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,023

11/16/2005

Luca Majer Doglioni

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EXAMINER

ALEXANDER, REGINALD

ART UNIT

PAPER NUMBER

3742

NOTIFICATION DATE

DELIVERY MODE

02/19/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,023	<b>Applicant(s)</b> MAJER DOGLIONI, LUCA	
	<b>Examiner</b> Reginald L. Alexander	<b>Art Unit</b> 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-15 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-15 and 20-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 30 is objected to because of the following informalities: The claim depends from cancelled claim 16. Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5-8, 10, 20-23, 25 and 31-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S.

Patent No. 7,100,496. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are merely an obvious variation of the patented claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-15 and 20-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fond '702 in view of Hu et al. '542.

There is disclosed in Fond a beverage preparation apparatus, comprising a collecting device 10 having a seat 25 suitable to receive a disposable cartridge 1 containing a soluble product 5, the cartridge comprising, during operation, an outlet opening for delivery of a beverage (see figure 3) on a bottom wall thereof, the collecting device comprises a piercing member 12 to pierce the cartridge in formation of the outlet opening, and further comprising means (delivery port positioned during a dispensing step between a wall of the piercing element and an edge of the outlet opening and extending around the perimeter of an engagement portion of the piercing element, see figure 3) of regulating delivery of the beverage from the capsule, and a plurality of tilted fins 13 to support the capsule and limit the deformation thereof.

Hu discloses that it is known in the art to define an outlet opening of a cartridge by a breaking line 21 present on a bottom wall of the cartridge.

It would have been obvious to one skilled in the art to provide the cartridge of Fond with the breaking line taught in Hu, in order to ensure a formation of the outlet opening at a proper pressure and deformation of the cartridge.

In regards to the claimed ratio between the diameter of the engagement portion of the piercing member and the diameter of the outlet opening, such a ratio is the function of result effective variable. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

In regards to the claimed tilt angles, such is dependent upon the desired deformation of the capsule and pressure at which the outlet opening is to open. Thus, it would have been obvious to one skilled in the art to choose any of the claimed angles to suit the desired use requirements.

In regards to claims 15 and 30, the capsules of both Hu and Fond are formed of an elastically deformable material.

Claims 5-15 and, 20-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. '542 in view of Fond '702.

There is disclosed in Hu a beverage preparation apparatus, comprising a collecting device 37 having a seat suitable to receive a disposable cartridge 10 containing a soluble product, the cartridge comprising an outlet opening for delivery of a beverage, wherein the outlet opening is defined by at least one breaking line 21 present on a bottom wall of the cartridge, and wherein the collecting device comprises a piercing member 40 to pierce the cartridge at the breaking line and to completely engage the outlet opening formed, and comprising means (channels 42 and a peripheral gap formed between the opening and the piercing member) of regulating delivery of the beverage.

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Fond, as discussed above, discloses the use of a cylindrical piercing member having an engagement portion which enters into a capsule, thus creating a delivery port which extends around the perimeter of the engagement portion.

It would have been obvious to one skilled in the art to substitute the collecting device and piercing member of Hu with that taught in Fond, in order to prevent any chance of the delivery port being blocked by the piercing member.

In regards to the ratio of diameters between the piercing member and outlet opening, it is stated in Hu (col. 16, lines 29-30) that the number of channels can be adjusted accordingly. The number of channels, along with the gap formed between the opening and piercing member, is directly related to the percentage of product dispensed over the total dispensing time. It would have been obvious to one skilled in the art to adjust the number of channels and/or the gap size between the opening and piercing member to provide the claimed results, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering an optimum value of a result effective variable involves only routine skill in the art.

In regards to claims 8-14 and 23-29, Fond discloses the use of tilted fins to support the capsule and limit the deformation thereof.

In regards to the claimed tilt angles, such is dependent upon the desired deformation of the capsule and pressure at which the outlet opening is to open. Thus, it would have been obvious to one skilled in the art to choose any of the claimed angles to suit the desired use requirements.

In regards to claims 15 and 30, the capsules of both Hu and Fond are formed of an elastically deformable material.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Hu et al. '597, Timm and Bunn et al. are cited for their disclosure of the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reginald L. Alexander whose telephone number is 571-272-1395. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Reginald L. Alexander/

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Primary Examiner  
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